

REMARKS/ARGUMENTS

In response to the Office Action dated December 9, 2010, Applicant amends his application and requests continued examination. In this Amendment claims 9-12 and 19 are newly cancelled and new claims 20 and 21 are added. Accordingly, claims 3-8, 13-18, 20 and 21 are now pending.

Request for a Personal Interview

Applicant's representative requests a personal interview with the Examiner before issuance of a first action in response to the Request for Continued Examination, unless that first action is a Notice of Allowance. The purpose of the interview is to discuss the invention and the claims and to display for the Examiner an embodiment of the invention, demonstrating its features. Contact information for the representative appears below.

Claim Amendments and Added Claims

In this Amendment the independent claims, claims 3 and 13, are similarly amended. The amendments are all supported by the patent application as filed and the brief specification. In analyzing the claimed invention, it is important to distinguish the two-part ring from the rigid ring, which is one of the parts of the ring. The ring includes the rigid ring, which is the core of the ring, and a rotor, which is the sheath or outer element of the ring. A lubricant is present between the rigid ring and the rotor, i.e., within the rotor. This arrangement is particularly illustrated and described with respect to Figures 2 and 4 of the patent application, although all figures must be considered together.

As shown in Figure 3, the ring structure is annular. In fact, both the rigid ring and the rotor are annular. Figures 2 and 4 are cross-sectional views of the ring structure, but only on part of the ring structure. An identical cross-sectional view of

the other part of the ring is omitted from those figures for clarity. In these embodiments, the rigid ring is element 4 or 9, the lubricant is element 7, and the rotor, which may be a rubber tube, is element 5 or 8.

As is apparent from the figures and the description, the outer sheath or rotor can slide with respect to the rigid ring. That sliding is a rotational movement in the invention. The rigid ring and the rotor have a common axis that is circular. That axis is in the very center of Figures 2 and 4, for example. Strictly with respect to those figures, the rotor rotates about that axis. Of course, in three dimensions, the relative motion between the rigid ring and the rotor is somewhat more complex. As the rotor turns relative to the rigid ring, parts of the rotor are placed into tension, at the outside of the ring, and other parts are placed into compression, at the inside of the ring. The applied force at a particular location on the rotor changes as the rotor is turned relative to the rigid ring. Thus, the rotor must be an elastic material to enable the relative rotation of the rotor about the common circular central axis of the two parts. This change in applied force with rotation is the basis of amended claims 7 and 15, which limit the rotor to a rubber tube, amended claims 8 and 16, and new claim 21. The intervening lubricant, between the rigid ring and the rotor, obviously reduces friction and the force needed to rotate the rotor with respect to the rigid ring.

The foregoing description, taken directly from the specification and drawings is the basis of the amendments to claims 3 and 13. Those amendments are identical as to the common parts of those two claims. New independent claim 20 is taken from amended claim 1 but specifies that the rotor is a rubber tube. In fact, the term "rotor" is not used in new claims 20 and 21. Dependent claim 4 is amended to conform to amended claim 3.

Rejection Pursuant to 35 USC 112

Claims 7 and 15 were rejected as not supported by the patent application as filed. The cancellation of those claims makes the rejection moot. Use of rubber for the rotor is described in the patent application as filed at page 5, line 8 and 9.

Prior Art Rejections

Claims 3-8, 11-16, and 19 were rejected as unpatentable over Tsugawa (Published U.S. Patent Application 2994/0089309) in view of Griffiths (Published U.S. Patent Application 2002/0139373). The prior art rejections of claims 9, 10, 17, and 18 are moot in view of the cancellation of those claims. The remaining rejection is respectfully traversed as to the claims that are now presented.

Response to Prior Art Rejection

A fundamental requirement to establish obviousness of a claim based upon a combination of prior art publications is that the publications must, in combination, disclose all of the elements of the claimed invention. Only if that prerequisite is established can more difficult issues, such as the propriety of combining the publications, be reached. The rejection here is erroneous because Tsugawa and Griffiths do not disclose all of the elements of independent claims 3 and 13 nor of the added independent claim 20.

In relying on Tsugawa, the Examiner directed attention to Figure 14 of that patent. According to page 23 of the Office Action, that figure shows a “rotor (83) that is a sheath covering (is located on) the rigid ring (82), the rotor (83) being rotatable with respect to the rigid ring (82)...”. This characterization is completely at odds with the single paragraph of Tsugawa that pertains to its Figure 14.

According to paragraph [0086] of Tsugawa, the “wearing device” shown there is element 81. There are only two other reference numbers in that figure. The cited paragraph states that

“constrictions 83 are formed in the shape of a hemisphere on the ring-shaped product 82, showing an entire shape in a state *as if* a number of beads are coupled.” (Emphasis added.)

What is shown in Figure 14 of Tsugawa is a one-piece molded element. To assert that the structure shown there has multiple parts is error because it is contrary to Tsugawa's description. Further, even if one extrapolates from what is described by Tsugawa to presume that what is shown is some kind of beaded structure, like a beaded light switch pull chain, there is no rigid ring that is a core sheathed by, i.e., enclosed within, an annular hollow rotor. The transformation of the unitary device of Tsugawa's Figure 14 into a two-part structure with two distinct elements to construct the prior art rejection should be withdrawn.

Moreover, the amended claims make clear the kind of rotation that takes place between the rotor and the core, i.e., the rigid ring. No such rotation can be achieved by the wearing device 81 in Tsugawa's Figure 14 because that device is unitary. Even if that device were an endless beaded chain, the kind of rotation described in the independent claims would still not be possible. Because of these additional distinctions from Tsugawa, reliance upon that publication should be withdrawn.

Griffiths was relied upon solely as describing use of a lubricant with a condom "wearing device," i.e., ring. According to the Office Action at page 3, "Griffiths teaches .. an analogous device with a lubricant located between the rigid ring (installation ring) and the rotor (rolled up condom)." This assertion is almost completely untrue.

All that Griffiths teaches in the cited paragraph [0027] is the use of a water soluble lubricant with a packaged and applied condom. Some figures of Griffiths depict an installation ring. No description in Griffiths has any relationship to a two-part ring including an internal rigid ring within an annular sheath. Thus, like Tsugawa, Griffiths fails to describe or suggest the two-part ring of the pending independent claims.

Further, asserting that the condom itself is a rotor makes not sense and is contrary to the claims. All claims separately account for the condom and the rotor. Therefore it is improper and illegal to assert that one element, here the condom, can do double duty and meet two distinct elements of the claims.

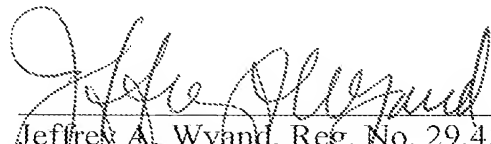
In addition, the reliance upon Griffith for the lubricant is contrary to the description of the present patent applicant and the claimed invention. In the invention, the lubricant is within the sheath, i.e., rotor, between the rotor and the core, i.e., rigid ring. The lubricant aids in the rotational, sliding movement of the sheath relative to the core, while the rotor continues to sheath the rigid ring.

In Griffiths, the lubricant is located only between the condom and the installation ring. In the invention, the claimed lubricant is not in contact with the condom. In Griffiths, the lubricant aids in sliding the installation ring. In the invention, the lubricant aids in relative movement between the parts of the ring, the core and the sheath. Therefore, nothing in Griffith, even if used to modify Tsugawa's head-like wearing device, can supply all of the limitations of the independent claims 3, 13, and 20, and, therefore, of the dependent claims 4-8, 14-16, and 21.

Tsugawa and Griffiths are missing the two parts of the ring of the claims and the lubricant between those two parts. Therefore, *prima facie* obviousness has not been established as to any claim now pending.

Reconsideration, withdrawal of the rejection, and allowance of claims 3-8, 13-16, 20, and 21 are earnestly solicited.

Respectfully submitted,


Jeffrey A. Wyand, Reg. No. 29,458
LEYDIG, VOIT & MAYER
700 Thirteenth Street, N.W., Suite 300
Washington, DC 20005-3960
(202) 737-6770 (telephone)
(202) 737-6776 (facsimile)

Date: March 4, 2011
JAW:os